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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,269	03/12/2004	Massimo Rossi	36494	8666
116	7590	11/27/2006	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/799,269	Applicant(s) ROSSI ET AL.	
	Examiner Tae H. Yoon	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2 (line 28), the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Improper Markush language is recited in lines 2-3 of claim 3, and a proper format is "selected from the group consisting of methyl, ethyl, phenyl, vinyl and 3,3,3-trifluoropropyl radical".

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 12-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jada (US 5,852,068).

Jada teaches the instant composition comprising a base polymer and a catalyst polymer at col. 3, lines 22-32 and in examples 1-3 wherein a mixture of polydimethylsiloxane having terminal vinyl groups in said each component and viscosities (1 cP = 1 mPa.s) thereof and silica are taught. Extending fillers in claim 10 would be optional when combined with claim 9 wherein a choice of the extending fillers and reinforcing fillers is claimed. The instantly recited "comprising" permits the presence of other component, and also, said polydimethylsiloxane having the lowest viscosity such as 1000 mPa.s would meet the instant silicon oil of claim 6. Said examples teach employing inorganic filler in said each component and said inorganic filler is taught at col. 5, lines 9-17 wherein the instant radio-opacifying fillers (such as zirconium silicate, zirconium oxide and zinc oxide) are seen. Choosing said radio-opacifying fillers for said examples would be anticipation since choice is very limited. See *In re Arkley*, 455 f2d 586, 172 USPQ 524 (CCPA 1972); *In re Petering*, 301 F2d 676, 133 USPQ 275 (CCPA 1962). Also, polydimethylsiloxane containing hydridosily group and chloroplatinic acid of example 1 meet the reticulating agent and catalyst, respectively.

Thus, the invention lacks novelty.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as obvious over Jada (US 5,852,068) in view of Smith (US 4,007,153) or Fiedler (US 5,830,951).

The invention further recites employing extending fillers having a BET surface area below 50 m²/g and silica over fillers of Jada (col. 5, lines 9-21 wherein calcium carbonate is taught). Silicic acid taught at col. 5, line 14 of Jada is silica. Lower the BET surface area, the lower the porosity, and filler with such property would have a low oil absorbption. Smith teaches such calcium carbonate at col. 5, lines 46-57 and Fiedler teaches that the lower surface area of the fillers would improve flowing of a low viscosity impression materials at col. 9, lines 5-10. Fiedler teaches the use of mixed fillers in examples.

It would have been obvious to one skilled in the art at the time of invention to utilize silica and/or calcium carbonate having the instant BET surface area (lower BET surface area) of Smith or Fiedler in Jada with or without silica since Jada teaches employing various fillers and since the use of mixed fillers in impression materials is well known as taught by Fiedler and since Smith and Fiedler teach employing advantage of employing low surface area (and thus low oil absorption) fillers absent showing otherwise.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as obvious over Bublewitz et al (US 6,313,190).

Bublewitz et al teach two-component system in examples 1-6 wherein the instant polydimethylsiloxane having terminal vinyl groups in said each component and viscosities and filler are taught. Also, polymethylhydrogensiloxane containing meet the reticulating agent, and organopolysiloxane col. 5, lines 61-64.

The instant invention further recites employing radio-opacifying fillers and other fillers over Bublewitz et al, but Bublewitz et al teach such modification at col. 3, lines 48, 49 and 61 and at cols. 5 and 6. Fillers having BET surface area of at least $50 \text{ m}^2/\text{g}$ are taught at col. 5, lines 23-28 and such filler would be substantially same as the instant fillers having a BET surface area below $50 \text{ m}^2/\text{g}$ since said below 50 could be 49.99, for example.


It would have been obvious to one skilled in the art at the time of invention to utilize radio-opacifying fillers and other fillers having the instant BET surface area (lower in Bublewitz et al since Bublewitz et al teach employing radio-opacifying fillers and other fillers and since the BET surface area of Bublewitz et al is substantially same as the instant fillers having a BET surface area below $50 \text{ m}^2/\text{g}$ absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tae H Yoon
Primary Examiner
Art Unit 1714

THY/November 20, 2006